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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,765	12/17/2007	Wilhelm Baruschke	016906-0527	7818

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FOLEY AND LARDNER LLP
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EXAMINER

NGUYEN, GEORGE BINH MINH

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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01/03/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,765	Applicant(s) BARUSCHKE ET AL.	
	Examiner GEORGE NGUYEN	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 27-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 27-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Applicant's amendment filed on November 05, 2010.

Claims 2-26 were canceled.

Claims 27-51 were added; Thus, claims 1 and 27-51 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 27-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood how the shutter #2 can be pivoted for setting a pivot area #15 of the air outflow vent #1 such that a direction of the air stream is set an area. In figure 6a, shutter #2 appears to show a plurality of concentric outlet opening #2.1; thus, it is not understood how the pivotable shutter #2 be able generate the flow characteristics #12, #13, #14, and the pivot area #15 as shown in Fig. 6a, and described in the specification, page 15, lines 27-30. The shutter #2 is not shown with any "louvers" or "structure" which can be pivoted to control the concentric outlet openings #2.1 in order to achieve the flow characteristics #12, #13, #14, and the pivot area #15 as shown in Fig. 6a . Thus, it would take one skilled in the art undue

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experimentation to figure out the structure of the shutter #2 to arrive at the flow characteristics set forth in the disclosed invention. The first embodiment shown in Figs. 4a-4B suffers the same lack of enablement issue described above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 27-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Due to the above 112 1st lack of enablement rejection above, claims 1 and 27-51 are indefinite because the scope of the claims are unascertainable. Specifically, the specific limitations of “to set a pivot area ... of the outlet opening” are not understood and confused.

Claim rejection under 112 4th paragraph

Claims 38-51 are rejected under 35 USC 112 4th paragraph, as being an improper dependent claim for failing to include all the limitations of the claim upon which it depends and for failing to further limit the subject matter of the claim upon which it depends. Specifically, claims 38-51 only requires the steps as set forth in the claims and does not require actually all structures of claim 1. Applicant should consider amending claim 38 so that it does not include any reference to claim 1. As the Federal Circuit treats non-compliance with 35 USC 112 4th paragraph as a patentability issue, it is considered more appropriate to treat a claim that does not comply with 35 USC 112 4th

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paragraph by rejecting the claim under 35 USC 112 4th rather than by objecting to such claim under 37 CFR 1.75(c) as provided for in MPEP 608.01(n)(II). See *Pfizer Inc. v. Ranbaxy Labs., Ltd.*, 457 F.3d 1284, 1291-92 (Fed. Cir. 2006).

No Art Rejection

Regarding to claims 1 and 27-51, normally a claim which fails to comply with the first and/or second paragraphs of § 112 will not be analyzed as to whether it is patentable over the prior art since to do so would of necessity require speculation with regard to the meets and bounds of the claimed subject matter, *In re Steele*, 308 F.2d 859, 862-63, 134 USPQ 292, (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385 496 USPQ 494, 496 (CCPA 1970).

Response to Arguments

Applicant's arguments with respect to claims 1 and 27-51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GEORGE NGUYEN whose telephone number is (571)272-4491. The examiner can normally be reached on Monday -Friday from 8 AM-4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hail Joseph can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

George Nguyen
Primary Examiner
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